

Atty. Dkt. No.: WT0115

B. AMENDMENTS TO THE DRAWINGS

Please add the attached sheet (FIG. 25) to the drawings originally filed with the application.

E. REMARKS

This Reply is in response to the Office Action mailed on February 16, 2005 in which claims 1-14 and 51-64 were rejected. With this Amendment, claims 1 and 14 are amended, an additional drawing sheet is added and the specification is amended to reference the additional drawing sheet. Claims 1-14 and 51-64 are presented by the Applicants for reconsideration and allowance.

1. OBJECTION TO THE DRAWINGS

Page 2 of the Office Action objected to drawings under 37 CFR 1.83(a). With this Amendment, new sheet, FIG. 25, is added. No new matter is added with this new sheet. Additionally, the Specification has been amended to reference new sheet, FIG. 25.

2. OBJECTION TO CLAIM 14

Page 3, Section 2 of the Office Action objected to claim 14 for lacking antecedent basis for the language "the outer layer." With this Response, Applicants amend claim 14 to correct its dependency from claim 12 to claim 13. Claim 13 provides the proper antecedent basis.

3. REJECTION OF CLAIMS 1-3, 5, 7, 9, 10 AND 51-64 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN

Section 4 of the Office Action rejected claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 4,570,931). Claim 1 is an independent claim and claims 2, 3, 4, 7, 9, 10 and 51-64 depend from claim 1. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art.

Independent claim 1, as amended, recites a football configured for use in competitive play and for grasping by a user's hand. The football includes a casing and an

outwardly extending lacing. The lacing is coupled to the laced region of the casing. The lacing has an exposed surface. At least a portion of the exposed surface of the lacing having a pebbled texture.

It is respectfully submitted that claims 1-3, 5, 7, 9, 10 and 51-64 are allowable over *Horkan* and *Martin*, either alone or in combination, because there is no suggestion to combine these references. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Horkan discloses a football training aid for young football players including a modified toy training football and a glove for use with the modified training football. The modified training football and glove combination allegedly assists in teaching a player to correctly grasp and throw a football. The lacing of the training football is replaced with Velcro® material, and the glove, worn by the young football player, includes corresponding Velcro® elements. “[T]he mating of the Velcro® elements 122 on glove 200 occurs *only* when the football 100 is properly grasped by a gloved 200 user at the laces 110 of football 100.” Col. 2, lines 44-47 (*emphasis added*). Accordingly, the modified training football of *Horkan* is specifically designed such that the gloved user can only properly grasp the modified training ball when the Velcro® elements on the user’s glove mate with the corresponding Velcro® material at the laces of the modified football. *Horkan* does not teach, suggest, or disclose improving or enhancing the grip of modified training football at any other location or without a gloved hand. In fact, *Horkan* teaches away from improving the graspability of the modified training football at other locations on the ball and without using the specific training glove. *Horkan* discloses enabling a young football player to properly grasp the modified training football only with a gloved hand and only when the Velcro® elements on the glove mate with the Velcro® lacing.

Martin, in contrast, is directed toward a basketball wherein the outer spherical surface of the basketball include rows of pebbles lying in the areas between the seams. The seams of the basketball are smooth and lack a pebbled texture. The pebbles on the outer spherical surface of the basketball between the seams are preferably triangular in shape, but also can be frustoconical or polygonal. *Martin* is devoid of any disclosure, teaching or motivation suggesting a combination with *Horkan*. *Martin* discloses only a basketball and does not teach or suggest a training football and glove combination in anyway. The basketball of *Martin* is configured to include pebbles between seams on the outer spherical surface of the ball for improving the gripability of the basketball overall. The basketball of *Martin* is configured to improve the grip of the basketball at the areas between the seams of the basketball and not at only one specific location on the ball. This is the opposite teaching of *Horkan*, who discloses the grasping of a modified training football only at the laces and only by the fingertips of a gloved user.

Further, the portion of the basketball of *Martin* that would be even remotely related to lacing of *Horkan* is the seams the basketball. Here, *Martin* specifically discloses and teaches that the seams are smooth and lack any pebbling or other feature to improve the gripability of the basketball at that location. Accordingly, *Martin* not only does not teach, suggest or disclose a combination with *Horkan*, *Martin* actually teaches away from such a combination.

Even ignoring this lack of disclosure and teaching, the modified training football and glove combination of *Horkin* cannot be practically combined with the basketball of *Martin*. An attempt to do such a combination would change the principle of operation of modified training football and glove combination of *Horkan* and the basketball of *Martin*. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” *MPEP* § 2143.02; *In re Ratti*, 270 F.2d 810 (CCPA 1959). As described above, applying the pebbles on the outer spherical surface of

the basketball between the seams of *Martin* to outer surface of the modified training football of *Horkan* would potentially improve the grip of the outer surface of the modified training football and defeat the purpose of *Horkan*, which is to provide a young football player with only one single location for grasping the football, such that the young football player learns the correct position. Further, *Martin* discloses smooth seams between the areas of pebbles on the spherical outer surface of the basketball. *Horkan* requires the use of a glove. Incorporating a glove and/or a lacing with the teachings of *Martin* would not result in a usable basketball.

Martin does mention the conventional seams on the basketball and specifically states that the seams are smooth. *Martin* is not only devoid of any disclosure or suggestion of a lacing, but the portion of the basketball that would be even remotely related to lacing, the seams the basketball, are specifically taught to be made of smooth non-pebbled surface. Accordingly, *Martin* teaches away from such a combination.

It is respectfully submitted that neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 1, as amended. In particular, neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose a football configured for use in competitive play and for grasping by a user's hand, wherein the football includes an outwardly extending lacing having a pebbled texture on at least a portion of an exposed surface of the lacing.

In contrast, as discussed above, *Horkan* discloses a football training aid including the combination of a modified toy training football and a glove wherein the lacing of the training football is replaced with Velcro® material, and the glove, worn by the young football player, includes corresponding Velcro® elements. The football training aid combination of *Horkan* is specifically configured to help teach a young football player a specific manner in which to grasp the training football. The modified training football and corresponding glove of *Horkan* is not configured for use in competitive play and is not configured for grasping by a user's hand. Further, as indicated by the Office Action, the

football of *Horkan* also does not include a lacing having an exposed surface wherein at least a portion of the exposed surface of the lacing has a pebbled texture.

In further contrast to the requirements of claim 1, *Martin* discloses a basketball wherein the outer spherical surface of the basketball include rows of pebbles lying in the areas between the smooth seams. *Martin* does not teach, suggest or disclose a football, a football configured for competitive play, a football for grasping by a user's hand, a casing having a laced region, or an outwardly extending lacing coupled to the laced region of the casing. *Martin* essentially discloses a conventional basketball with a pebbling in areas between seams. *Martin* also discloses the use of triangular, frustoconical or polygon shaped pebbles but only in the pebbled areas of a conventional basketball.

Horkan, *Martin* and the prior art of record do not teach, suggest or disclose a football including a casing having a laced region and an outwardly extend lacing coupled to the casing, wherein at least a portion of an exposed surface of the lacing has a pebbled texture. A football made in accordance with the present invention satisfies the long-felt and previously unmet need to further improve the grippability of existing footballs.

Neither *Horkan* nor *Martin* teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that amended claim 1 overcomes the rejection based upon *Horkan* in view of *Martin*, and is believed to be in condition for allowance. It is also respectfully submitted that claims 2, 3, 4, 7, 9, 10 and 51-64, which depend from amended claim 1, are patentable over *Horkan* and/or *Martin* for at least the same reasons.

4. ***REJECTION OF CLAIMS 4, 8, 11, 12 AND 14 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FEENEY***

Section 5 of the Office Action rejected claims 4, 8, 11, 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Feeney* (U.S. Patent No. 6,283,881). Claims 4, 8, 11, 12 and 14 each depend from independent claim 1, as

amended. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art. It is respectfully submitted that claims 4, 8, 11, 12 and 14 are patentable over *Horkan* in view of *Martin* and *Feeney* for at least the same reasons as discussed above relating to claim 1, as amended. *Feeney* discloses a basketball having a bladder, a carcass over the bladder and a plurality of panels coupled to an exterior surface of the carcass. The outer surface of the panels are formed with a plurality of raised projections. The projections are formed in loops with supplemental projections there within. *Feeney*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1, as amended. In particular, *Feeney* does not teach, suggest or disclose a football configured for use in competitive play and for grasping by a user's hand, wherein the football includes an outwardly extending lacing having a pebbled texture on at least a portion of an exposed surface of the lacing.

Horkan, *Martin* and *Feeney*, alone or in combination, do not teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that claims 4, 8, 11, 12 and 14, which depend from amended claim 1, are patentable over *Horkan*, *Martin*, and *Feeney* for at least the same reasons.

5. ***REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FINLEY***

Section 6 of the Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Finley* (U.S. Patent No. 4,991,842). Claim 6 depends from independent claim 1, as amended. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art. It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin* and *Finley* for at least the same reasons as discussed above relating to claim 1, as amended. *Finley* discloses a spherical basketball having a plurality of recesses formed on the exterior of the basketball and a network of interconnected ridges

separating adjacent ridges. *Finley*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1, as amended. In particular, *Finley* does not teach, suggest or disclose a football configured for use in competitive play and for grasping by a user's hand, wherein the football includes an outwardly extending lacing having a pebbled texture on at least a portion of an exposed surface of the lacing.

Horkan, Martin and Finley, alone or in combination, do not teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that claim 6, which depend from amended claim 1, is patentable over *Horkan, Martin, and Finley* for at least the same reasons.

6. REJECTION OF CLAIMS 1-3 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774

Section 8 of the Office Action rejected claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774. With this Reply, Applicants submit terminal disclaimers to obviate these double patenting rejections. In particular, Applicants submit a separate executed USPTO Form PTO/SB/26 entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, U.S. Patent No. D457,208, and U.S. Patent No. D480,774.

7. REJECTION OF CLAIMS 5, 7, 9, 10 AND 51-64 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774

Section 9 of the Office Action rejected claims 5, 7, 9, 10 and 51-64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774. With this Reply, Applicants submit terminal disclaimers to obviate these double patenting rejections. In particular, Applicants submit a separate executed USPTO Form PTO/SB/26 entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, U.S. Patent No. D457,208, and U.S. Patent No. D480,774.

8. REJECTION OF CLAIMS 4, 8, 11, 12 AND 14 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774

Section 10 of the Office Action rejected claims 4, 8, 11, 12 and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774. With this Reply, Applicants submit terminal disclaimers to obviate these double patenting rejections. In particular, Applicants submit a separate executed USPTO Form PTO/SB/26 entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, U.S. Patent No. D457,208, and U.S. Patent No. D480,774.

9. REJECTION OF CLAIM 6 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774

Section 11 of the Office Action rejected claim 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S.


Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774. With this Reply, Applicants submit terminal disclaimers to obviate these double patenting rejections. In particular, Applicants submit a separate executed USPTO Form PTO/SB/26 entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, U.S. Patent No. D457,208, and U.S. Patent No. D480,774.

10. CONCLUSION

Applicants respectfully request reconsideration of claims 1-14 and 51-64. Applicants believe that the present application is now in condition for allowance. The Examiner is invited to telephone the undersigned to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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